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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/290,170	04/13/1999	HIROSHI ARITA	H-7769	9549

24956 7590 10/16/2003

MATTINGLY, STANGER & MALUR, P.C.
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SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

TOATLEY, GREGORY J

ART UNIT	PAPER NUMBER
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2836

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/290,170

Applicant(s)

ARITA ET AL.

Examiner

Gregory J. Toatley, Jr.

Art Unit

2836

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/13/99 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because the blank boxes in figs. 3, 4, 6, and 11 should have a descriptive label. Any structural detail that is of sufficient importance to be described should be shown in the drawing. MPEP § 608.02(d). Correction is required.

Specification

2. The examiner respectfully suggests that the Applicant carefully review the specification for idiomatic and grammatical errors, which may have inadvertently overlooked.

Claim Rejections - 35 USC § 112

3. The applicant has addressed the rejection under 112 1st paragraph. The rejection has been withdrawn

Art Rejection Rationale

At the outset, the examiner notes that claims are to be given their broadest reasonable interpretation during prosecution. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969); In re Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984); Burlington Indus. V. Quigg, 822 F.2d 1581, 3 USPQ2d 1436 (Fed. Cir. 1987); In re Morris, 43 USPQ2d 1753, 1756 (Fed. Cir. 1997). In responding to this Office action, applicants are reminded of the requirements of 37 CFR §§ 1.111 and 1.119 that applicants specifically point out the specific distinctions believed to render the claims patentable over the references in presenting responsive arguments. See M.P.E.P. § 714.02. The support for any amendments made should also be specifically pointed out. See M.P.E.P. § 2163.06.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 38 - 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior elements in view of NEW SCIENTIST.

It is to be noted that the independent claims 1-3 were previously drafted in the JEPSON format, thus making an implied admission of prior art of the preamble elements. The examiner thus interprets the previously recited preamble elements to be admitted prior art and hence the improvement portions of the claims are what applicants deem to be novel and lacking from the admitted prior art. Thus applying this admission of prior art to the recently amended claims results in a similar treatment of that claim. See MPEP 2129. Applicant has already admitted that such is well known per the previously drafted JEPSON

language. Thus applicant has set forth what is admitted prior art. To merely redraft the claims to remove such from the instant claims does not remove the admission of prior art already made in the file.

The admitted prior art sets forth cross border power transfer with path mounted measuring equipment. What is lacking is control and generation of electricity and its directional flow based upon the output of the measuring equipment. NEW SCIENTIST clearly sets forth many objectives and advantages of a global power grid. In order to address; the independent claims, it sets forth at page 4 that the international links allow for exportation of spare generating capacity from France to meet peak load demand in Britain. This is clearly indicative of the knowledge of capacity and demand in both France and Britain so as to be able to meet the loads of both. Note, also the exportation of Swiss power to France to meet peak load demand. Thus numerous examples of cross border electricity traffic are given for the purpose embodied in the independent claims. Thus it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify the admitted prior art per the teachings of the New Scientist for the purpose of being able to share generating capacity and smooth out surges in demand by exporting spare generating capacity from one country to another when the peak loads in the countries differ. This clearly requires the ability to know and sense when peak power is need in one country so that the surplus from another country can be supplied when it is needed. Thus the combination renders the claims obvious. The New Scientist also teaches many other features, rendering other claims obvious as well. Note the use of numerous types of power (hydro, geothermal). Note the supplying of Africa with a single grid, thus covering numerous time zones as well as, above and below equatorial distribution. Since numerous

Art Unit: 2836

countries of differing monetary units and languages are involved, it is obvious that complex cross border systems take into account such factors and provide means to accommodate for such in order to effectively carry out the business dealings fairly, effectively, and equitably. Clearly such cross border systems also require sophisticated communications systems and hence the mere inclusion of such are deemed to be obvious subject matter within the level of ordinary skill in the art. Certain monetary units (i.e. US Dollar, Swiss Franc, Deutsche Mark) are recognized standards of international trade and hence to peg transactions to such is merely common business practice well known to those skilled in the art. Note the discussion of laying of cables, an Alaska link, thus rendering obvious the "transport route of another kind of energy" as pipelines for gas and oil are commonly run underwater and across Alaska. Note also a grid for the Pacific Ocean "ring of fire". Note the use of DC links for German/Czech crossings. The trading of emissions credits in electricity production is well-known and hence obvious subject matter. Common sense dictates that power flow from "good" to "poor" producers as a "good" producer would not want to rely upon a "poor" source as such would simply contravene sound business practice. Now to merely contemplate, as applicant has only done at page 11 of the specification and shown on Figure 1, that a distribution network can extend between the claimed continents is still rendered obvious per the page 2 disclosure of the NEW SCIENTIST which clearly shows that Buckminster Fuller dreamt of continents linked by high-voltage pylons and undersea cables to form a global electricity grid to distribute power from the rainforests of Borneo and the geothermal rocks of Iceland and the Zaire river and France's nuclear power plants. Page 1 even contemplates connection from Siberia to North

America, via the Bering Strait. Thus the particular routes are rendered obvious when considering the full extent of the NEW SCIENTIST and the admitted prior art.

Response to Arguments

7. The arguments of the applicants regarding the rejection under 35 USC 112 first paragraph are rendered moot based upon the "new" grounds of rejection. The rejection of claims 1 – 37 (in the office action mailed 6/14/02) has been repeated with regard to claims 38 – 67. The applicant has not clearly distinguished their invention from the taught system of the "New Scientist" paper. The distances that the applicant proposes transmit power were well known to be within the knowledge of those of ordinary skill of the art at the time of invention. The specific algorithms claimed are deemed to be obvious variants of the proposed factors disclosed by the "New Scientist" paper. The examiner respectfully suggests that the applicant particular point out how these features are distinguished from the prior art.

Pertinent Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The non-patent disclosures listed in the PTO form PTO-892 contain descriptions of prior art international power systems with features similar to the claimed and disclosed invention. The reference of Pitchford et al. (US 6327541) teaches of a distribution system with measurement devices between the supplier and the user. The reference of Naganuma et al. (SU 5537339 A) teaches of the control of the operations of plurality of utilities based upon transmitted factors from the utilities.

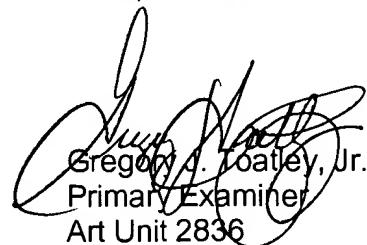
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Toatley, Jr. whose telephone number is 703-308-7889. The examiner can normally be reached on Mon. - Fri. 7:00 a.m. to 3 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (703) 308-3119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.


Gregory J. Toatley, Jr.
Primary Examiner
Art Unit 2836

GJT Jr.